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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/840,077	04/24/2001	Patrick Michael McCaffrey	ROC920010057US1-IBM 204	2562
7590 03/26/2004			EXAMINER	
Robert H. Berdo, Jr. RABIN & CHAMPAGNE, P.C. Suite 500 1101 14th Street, N.W. Washington, DC 20005			OJINI, EZIAMARA ANTHONY	
			ART UNIT	PAPER NUMBER
			3723	12
DATE MAILED: 03/26/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/840,077

Applicant(s)

MCCAFFREY ET AL.

Examiner

Anthony Ojini

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 21-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 21-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Applicant's cancellation of claims 10-20 in Paper No. 11 are acknowledged.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-9, 21-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Schweitzer et al.** (3,856,472) in view of **Kojima et al.** (3,990,990).

With respect to claims 1, 9, 21, 29, Schweitzer et al disclose a plurality of disks (5,6), stacked upon each other (see fig. 2).

Schweitzer et al. fail to disclose a plurality of fine, loose particles constituting a powder for facilitating removal of the first disk from the second disk, and protecting the first disk and the second disk when the second disk is stacked upon the first disk. **Schweitzer et al** also fails to disclose the first disk is spaced apart from the second disk by only the powder.

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Kojima et al. disclose a plurality of fine, loose particles constituting a powder for preventing adhesion substrate material to adjacent surfaces (see col. 1, lines 8-38 & claim 14).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide product of Schweitzer et al with a powder disposed adjacent surfaces of the substrates in view of **Kojima et al.** so as to prevent the disks from sticking to each other.

With respect to claims 2, 22, Schweitzer et al. disclose each disk comprises a glass and a glass-ceramic.

With respect to claims 3, 23, Schweitzer et al. fail to disclose a powder that spaces the first disk and from the second disk.

Kojima et al. disclose a plurality of fine, loose particles constituting a powder for preventing adhesion substrate material to adjacent surfaces (see col. 1, lines 8-38 & claim 14).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide product of Schweitzer et al. with a powder disposed adjacent surfaces of the substrates in view of **Kojima et al.** so as to space and prevent the disks from sticking to each other.

With respect to claims 4-7 and 24-27, Schweitzer et al. disclose powder (form of mineral powder) comprising an inorganic material that is selected from the group consisting of calcium carbonate, magnesium carbonate (see col. 1, lines 13-19).

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With respect to claims 8, 28, Schweitzer et al. fails to disclose wherein the powder has a size of about 200 mesh. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide product of **Schweitzer et al.** with powder that has a size of about 200 mesh **so as to firmly prevent adhesion between two surfaces**, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Response to Amendment

Applicant's arguments filed 12/3/03 have been fully considered but they are not persuasive.

Applicant argues that "neither the Examiner nor the Office have yet acknowledged that the Petition filed with Applicants' response to the Restriction Requirement has been forwarded to the Commissioner for review of the Examiner's requirement". However, no Petition filed with Applicants' response to the Restriction Requirement has been forwarded to the Commissioner for review of the Examiner's requirement.

Applicant argues that in Japanese Patent 10208301 to Abiko "this reference specifically teaches away from this claimed feature". However, Kojima et al. discloses the concept of a plurality of fine, loose particles constituting a powder for preventing adhesion substrate material to adjacent surfaces powder.

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Applicant argues that "Examiner's action has failed to establish a prima facie case of obvious against independent claim 1 and dependent claims 2-8".

However, Examiner has established a prima facie case of obvious against independent claim 1 and dependent claims 2-8.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Weber et al., Rizzo, Moore et al., Simon Hendrick BertramI disclose material for protecting surfaces of substrate respectively.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Ojini whose telephone number is 703 305 3768. The examiner can normally be reached on 7 to 4 Tuesday-Friday with every other Monday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Hail can be reached on 703 308 2687. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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AO
March 22, 2004